



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,696	11/20/2001	Joel B. Shamitoff	SHAM-01003US1	9731

7590

07/17/2003

Brian I. Marcus, Esq.  
Vierra Magen Marcus Harmon & DeNiro, LLP  
Suite 540  
685 Market Street  
San Francisco, CA 94105-4206

EXAMINER

MILLER, BENA B

ART UNIT

PAPER NUMBER

3712

DATE MAILED: 07/17/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/989,696

Applicant(s)

SHAMITOFF, JOEL B.

Examiner

Bena Miller

Art Unit

3712

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 3-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

**DERRIS H. BANKS**  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

Continuation of 2. NOTE: The claims, as now amended, raises new issues that would require further consideration and/or search. In this instance, claims 1-8 raises a 35 USC 112, 2nd issue (for example only, claim 4 recites "A toy as recited in claim 0"). Yet in another instance newly submitted claims 23 and 24 raises new issues.

Continuation of 5. does NOT place the application in condition for allowance because: In reference to applicant's comments regarding the indefiniteness of the claims under 35 USC 112, 2<sup>nd</sup> paragraph, the examiner considers the limitations not to avoid the outstanding rejection as set forth in the prior Office Action.

In reference to applicant's argument that Alger fails to teach the limitations of claims 3 and 8-18, the examiner disagrees. It should be noted, for example only, in claim 3, applicant recites the elements "including at least one of" in line 3 of the claim, whereas in line 13 of the claim recites "one or more snap portions affixed to at least two of said snapable elements". It is unclear if the elements includes at least one or at least two. For these reasons, since it is unclear to the examiner and the claim is indefinite, Alger teaches the elements of the claimed invention.

In reference to applicant's argument that Hay fails to teach the claimed invention. The examiner disagrees. Hay teaches the elements of the claims.

In reference to applicant's argument that the combination Alger and Divvleeon fails to teach the claimed limitations, the examiner disagrees. Alger meets the limitation as mentioned above and Divvleeon teaches a plush toy having attachable elements. Therefore, the combination meets the limitations of the claims.

In reference to applicant's argument that the combination of Alger and Rodgers and the combination Alger and Milliard fails to teach the limitation, the examiner disagrees. As indicated above, Alger teaches the claimed elements of the invention and the combination of Rodgers and Milliard, respectively, teaches the disclosed invention.